

REMARKS

Claims 1-36 were pending in the present application. By virtue of this response, claims 1-36 have been cancelled, and new claims 37-58 have been added. No claims have been amended. Accordingly, claims 37-58 are currently under consideration. Amendment and cancellation of certain claims is not to be construed as a dedication to the public of any of the subject matter of the claims as previously presented.

Claim Rejections under 35 U.S.C. §102(b)**Claims 1-5, 10, and 15**

Claims 1-5, 10, and 15 stand rejected under 35 U.S.C. §102(b) as allegedly anticipated by U.S. Patent No. 5,242,456 to Nash et al. (“Nash”). Claims 1-5, 10, and 15 have been canceled rendering the rejection of these claims moot. However, for the purpose of expediting prosecution, Applicants would like to take the opportunity to discuss why Nash would be an inappropriate reference to rely upon for either novelty or obviousness purposes with respect to the newly added claims.

Newly added independent claims 37, 49, and 57 (from which all other claims depend) each require, and positively recite, that each clip be “capable of penetrating tissue.” Support for this limitation can be found throughout Applicants’ specification, *see, e.g.*, ¶ [0010] stating that “the term ‘clips’ is intended to refer to a wide variety of tissue anchors or fasteners which are able to (1) penetrate and fix to tissue, particularly into the fibrous tissue of a heart valve annulus...” This is an important feature of Applicants’ clips—they are left behind after they become secured into the annular tissue and are used to shorten or reduce the circumference of the annular tissue (e.g., to treat regurgitation). Applicants’ invention would be inoperable for its intended purpose if the claimed clips were unable to penetrate tissue.

This is in contradistinction to Nash, whose clips are used for tissue deflection during surgical procedures so that a surgeon may gain better access to, or have better visualization with

respect to, target tissue. (*See, e.g.*, Col. 1, ll. 17-21). The clips of Nash are placed in the body only temporarily and are not intended for tissue penetration or fixation over any prolonged period of time. Indeed, Nash specifically states that “irrespective of the size or shape of the clips, each is constructed and arranged to be oriented so its mouth is open by the time it is adjacent the tissue to be grasped and its biasing means actuated to cause the clip to snap closed to grab or grasp the tissue *without penetrating it.*” (Col. 6, ll. 23-27, emphasis added). Nash goes on to re-emphasize that “[t]hat wave gets trapped between the jaws, i.e., within the mouth of the clip, to result in a firm, reliable, yet *non-penetrating* grasp on the tissue.” (Col. 6, ll. 37-39, emphasis added).

Thus, the use of Nash as a novelty reference with respect to the currently presented claims would be improper for at least the reason that Nash fails to disclose clips that are capable of penetrating tissue.

Claim Rejections under 35 U.S.C. §103(a)

Claims 6-9, 11-14, 16-36

Claims 6-9, 11-14, and 16-36 stand rejected variously under 35 U.S.C. §103(a). In each of the rejections, Nash is used as the primary reference. Specifically, claims 6-8 stand rejected over Nash in view of U.S. Patent No. 5,760,695 to Northrup, III (“Northrup”), claim 9 stands rejected over Nash in view of U.S. Patent No. 6,306,149 to Meade (“Meade”), claims 11-14 stand rejected over Nash in view of U.S. Patent No. 6,328,727 to Franzier (“Franzier”), claims 16-22, 26-28, and 33-36 stand rejected over Nash in view of Meade, Northrup, and U.S. Patent No. 5,766,240 to Johnson (“Johnson”), claims 23-25 stand rejected over Nash in view of Northrup and Johnson, and claims 29-32 stand rejected over Nash in view of U.S. Patent No. 5,524,630 to Crowley (“Crowley”).

Claims 6-9, 11-14, and 16-36 have been canceled, thus rendering the rejections of these claims moot. Applicants would simply like to note, however, that Nash (the primary reference used in all the outstanding obviousness rejections) is an inappropriate reference to rely upon for obviousness for at least the reasons that its teachings are directed toward solving an entirely

different problem, and that it specifically teaches away from the present invention, as described briefly above. Similarly, the remaining references are in such disparate fields, that an ordinary artisan seeking to arrive at the present invention would not look for guidance in their combined teachings. Indeed, Applicants respectfully submit that any allegation of a motivation to combine any of the cited references (with Nash or with each other) would be an improper hindsight reconstruction based on the teachings of their own specification. Accordingly, Applicants submit that the currently cited references do not support, and cannot properly be used to maintain, an obviousness rejection of the presently pending claims.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Applicants respectfully request that the Examiner withdraw all outstanding rejections of the claims and pass this application to issuance. The undersigned would welcome the opportunity to discuss the merits of the claims with the Examiner if it will aid in examination and/or expedite prosecution. Accordingly, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 578492000510. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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